

REMARKS REGARDING THE BOARD'S REJECTION

The Board reversed the Examiner's rejections, but made a new rejection of claims 1 to 12 under 35 U.S.C. §251 as being based on a defective reissue declaration. The Board stated that the declaration was defective because "there is nothing in the original patent evidencing that the appellant intended to claim an invention involving the species wherein the enclosure was made from two pieces of material." Decision at 8. The Applicants believe that, with the cancellation of claim 12 and the addition of claim 14, all the claims are now allowable.

A brief review of this case may be helpful. The Applicants' invention pertains to an apparatus which enhances the sense of touch. As acknowledged by the Board on page 5 of its decision, the Applicants disclosed two species in the original application - a first species wherein the enclosure is formed from "a single piece" of material and a second species wherein the enclosure is formed from "a plurality of pieces" of material. Independent claim 1 of the original application, as originally presented, did not specify the number of pieces from which the enclosure is made. Independent claim 1 was later amended to specify that the enclosure is made from a single piece of material (the first species).

In the present reissue application, independent claim 12 originally recited that the enclosure is made from "a plurality of pieces" (the second species). Claim 12 was later amended to recite that the enclosure is made from "two pieces" of material (a third species). The claim was in this form when this case was appealed to the Board.

As stated above, the Board's rationale for its new rejection was that there had been no specific mention of a two-piece enclosure in the original application. In contrast, there had been, as the Board noted, disclosure and reference to enclosures made from "a single piece" of material (the first species) and from "a plurality of pieces" (the second species). Furthermore, both the first species and the second species were included within claim 1 of the original application. Therefore, it follows that the Board's new rejection would not apply to newly added claim 14 which recites the second species - an apparatus with an enclosure made from "a plurality of pieces."

Based on the amendments and the above remarks, allowance of claims 1 to 11 and claim 14 is requested.

Respectfully submitted,

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CERTIFICATE OF MAILING

PHILIP L. BATEMAN certifies that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C., 20231, on September 24, 1991.

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